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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,775	12/08/2000	Hans A. Mische		2947
28534 7590 06/23/2009 MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP 1700 WEST PARK DRIVE WESTBOROUGH, MA 01581				
EXAMINER				
PATEL, NIHIR B				
ART UNIT		PAPER NUMBER		
3772				
MAIL DATE		DELIVERY MODE		
06/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/733,775

Applicant(s)

MISCHE, HANS A.

Examiner

NIHIR PATEL

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 11, 14, 15 and 18-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 10 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18th, 2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims **1, 2, 9, 10, 16, 17 and 25-27** have been considered but are moot in view of the new ground(s) of rejection.

Response to Amendment

3. The examiner acknowledges the amendment filed on June 18th, 2009. The amendment comprises amending claims 1, 2, 9, 10, 16, 17 and 25; cancelling claims 11 and 12; and withdrawing claims 3-8, 11, 14, 15 and 18-24. Thus claims 1, 2, 9, 10, 16, 17 and 25-27 are currently pending.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims **1, 2 and 9** are rejected under 35 U.S.C. 102(b) as being anticipated by Murray (US 4,627,434).
6. **As to claim 1**, Murray teaches an apparatus that comprises a delivery catheter (**see figs. 1 and 11; col. 3 lines 24-30**); an expandable implant **128** for occupying space within bones (**see figs 11 and 12; col. 8 lines 45-50**), releasably carried by the delivery catheter; and an inflatable means **80** of expanding the expandable implant (**see figs. 11 and 12**), the inflatable means of expanding configured for removal from the bone upon expansion of the expandable implant (**see col. 10 lines 10-20**); whereby the expandable implant mechanically is configured to fixate the fracture after the delivery catheter and the inflatable means of expanding the expandable implant are removed from the bone, leaving the expandable implant within the bone (**see col. 10 lines 10-20**).
7. **As to claim 2**, Murray teaches an apparatus wherein the inflatable means of expanding the expandable implant is an inflatable portion of the delivery catheter configured for removal from the bone after expanding the expandable implant (**see col. 10 lines 10-20**).
8. **As to claim 9**, Murray teaches an apparatus wherein the expanded implant joins separated bone segments (**see col. 10 lines 5-16; the fact that the cement fills the canal is defined as joining the separated bone segments**).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims **10 and 25-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (US 4,627,434).

12. **As to claims 10 and 25-27**, Murray substantially discloses method steps comprising providing an expandable implant **128** for occupying space within a bone segment (**see col. 10 lines 10-20**); creating an access hole in bone (**see figs 11 and 12**); disposing the expandable implant upon a delivery device **10** (**see figs. 11 and 12**), the delivery device comprising a balloon **80** **see figs 11 and 12; col. 7 lines 1-10 and lines 65-68**); inserting the expandable implant through the access hole within the bone segment (**see figs. 11 and 12**); advancing the expandable implant to a desired location within the bone segment (**see col. 8 lines 33-40**); inflating the balloon in order to cause expansion of the expandable implant (**see figs. 11 and 12**); removing the balloon from the bone (**see col. 10 lines 10-20**); and hardening a substance within the bone segment after the removing the balloon step (**see col. 10 lines 10-20**).

The method steps would have been obvious because they would have resulted from the use of the device of Murray.

Allowable Subject Matter

13. Claims **16 and 17** are allowed. The prior art does not disclose an expandable tubular implant configured to expand from a reduced configuration to an expanded configuration, the expanded configuration comprising a greater diameter and a shorter axial length than the reduced configuration.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIHIR PATEL whose telephone number is (571)272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/733,775
Art Unit: 3772

Page 6

/Nihir Patel/
Examiner, Art Unit 3772

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772